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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,587	11/06/2001	Wayne Oliver Forrest	DP-304904	8266

7590 03/23/2004  
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EXAMINER

FORD, JOHN K

ART UNIT PAPER NUMBER

3753

DATE MAILED: 03/23/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/992587

Applicant(s)

Forrest et al.

Examiner

FORD

Art Unit

3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 7, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2

- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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Any relevant prior art from the prosecution of EP 1,308,327 must be cited in response to this action.

Applicant's election of claims 1-4, with traverse, is acknowledged. The traverse, based on the allegation that claim 5 could have been presented as a dependent claim, has been carefully considered. The Examiner has no problem with rejoining claim 5 as a dependent claim if applicants rewrite it as such. Absent that the Examiner maintains that claim 5 as currently written does not include all of the limitations of claim 1 and hence, technically, could not be rewritten as a dependent claim unless additional limitations from claim 1 were added. To be perfectly clear, the Examiner will allow claims 5, 6, and 7 rewritten as dependent claims, from claim 1, assuming an allowable claim 1 is found. Until then the restriction requirement is deemed proper and made final.

The Examiner recalls recently allowing SN 10/014408 which is very related to this application. Are there any other applications related to this application, which the Examiner should be aware of?

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/041,408. Although the conflicting claims are not identical, they are not patentably distinct from each other because they simply claim the same rejection here more broadly than in SN 10/041408 (corresponding to US 2003/0127219A1). The rationale for requiring terminal disclaimer is set forth in the Goodman case, supra.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear in claim 4 whether applicant is claiming all the alternatives or if the claim would be satisfied by prior art disclosing one of the alternatives.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshioka (USP 4,383,574).

Yoshioka discloses a refrigeration system having a compressor 4, driver manipulated switch (24 or 23), evaporator 2, a temperature control mechanism (11 and associated hardware), a driver-manipulated temperature selector 13.

A "first control schedule" is defined in the region of cold and med when the compressor capacity is varied and the air-mix door is held closed. A "second control schedule" is defined in the region from med to hot when the air conditioning mode is disabled.

Similarly, when switch 23 is actuated a first control schedule of compressor capacity (full) and air mix door position (varied from med to hot) is defined. When switch 23 is disabled the air mix door position is varied according to a second control schedule which is similar to the first one except for the fact that the compressor is not actuated.

Regarding claim 2, this is disclosed in the cold and med operation mode when the dehumidify switch is de-actuated. See the feedback loop connected to sensor 25. The desired temperature at the evaporator is substantially  $0^{\circ}\text{C}$ - $2^{\circ}\text{C}$ . See col. 6, lines 12-19 of Yoshioka. Regarding claims 3 and 4, switches 23 and 24 and 25 are deemed "entry conditions" giving the term its broadest reasonable interpretation.

Finally, while it is not necessary to find anticipation based on a narrow reading of the disclosure it is noted that implicit in applicant's method steps is the underlying use of

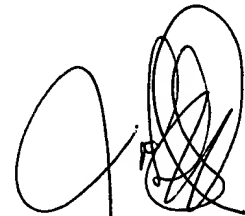
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a microcomputer to implement the control algorithm. To have suitably programmed any known microcomputer automobile HVAC system of which official notice is taken with a program to mimic the analog system functions of Yoshioka would have been obvious to one of ordinary skill since the cost of these systems has dropped dramatically to the point where they are ubiquitous in the automotive HVAC field.

Any inquiry concerning this communication should be directed to John Ford at telephone number <sup>703</sup>308-2636.  
A

Ford/DI

February 23, 2004

A handwritten signature in black ink, consisting of a large, stylized 'J' followed by a series of loops and a final flourish.

**John K. Ford**  
**Primary Examiner**